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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,813	02/26/2002	Tracy Ann Willson	14730	6320
7590 11/16/2004 Scully Scott Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			EXAMINER LANDSMAN, ROBERT S	
			ART UNIT 1647	PAPER NUMBER
DATE MAILED: 11/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,813

Applicant(s)

WILLSON ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 21, 22, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/21/02
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Formal Matters

- A. The Amendment entered 10/4/04 has been entered into the record.
- B. Claims 1-25 are pending in the application. Claims 1-19, 21, 22, 24 and 25 have been withdrawn as being drawn to a non-elected invention. Therefore, claims 20 and 23 are the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Specification

- A. The Sequence Listing has been entered into the record. Applicants did state in the Response dated 10/4/04 that the paper copy and the computer-readable form are the same. **However**, no statement has been made regarding the listing not containing new matter. **Furthermore**, the sequence "SPRY" on page 2, line 15 of the specification is not identified by a SEQ ID NO.
- B. The objection to the specification has been withdrawn in view of Applicants' amendments to recite "Figures 1A-1B" and "Figures 7A-7B."

3. Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- A. Claims 20 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The intention of the claims is to either inhibit or promote protein degradation by affecting an SOCS box/elongin C interaction. However, the invention encompassed by these claims has no apparent or disclosed patentable utility. Applicants have not provided the utility of the proteins which comprise this SOCS box. Therefore, Applicants have not provided a utility of the claimed screening methods. It is not understood what the effects would be of inhibiting or promoting the degradation of all of the proteins which meet the limitations of these claims. This rejection is consistent with the current utility guidelines, published 1/5/01, 66 FR 1092. The instant application has provided a description of a screening method. However,

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the instant application does not disclose a specific and substantial biological role of this protein or its association with any disease state.

4. Claim Rejections - 35 USC § 112, first paragraph

A. Claims 20 and 23 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

5. Claim Rejections - 35 USC § 112, second paragraph

A. Claim 23 remains rejected under 35 USC 112, second paragraph, for the reasons already of record on page 3 of the Office Action mailed 3/30/04. Applicants have overcome the rejection of claim 20 by providing a SEQ ID NO and arguing that one of skill in the art would understand the term "SOCS box." **However**, it is not clear why Applicants have not added a SEQ ID NO to claim 23.

B. Claim 20 remains rejected under 35 USC 112, second paragraph, for the reasons already of record on page 3 of the Office Action mailed 3/30/04. Applicants have overcome the rejection of claim 23 by presenting persuasive arguments that the artisan would know what assays could be used to promote an interaction between two proteins. However, in claim 20, it is not clear how the term "interferes" is defined. Claim 20 is drawn to a method of inhibiting protein interaction. It is suggested that the term "interferes" be amended to "inhibits" unless Applicants can provide arguments as to why "interferes" is sufficient.

6. Claim Rejections - 35 USC § 102

A. Claims 20 and 23 remain rejected over Kamura et al. Applicants argue that Kamura teach SOCS box/elongin BC complex increases expression of the SOCS-I protein by inhibiting its degradation, whereas the present invention teaches SOCS box/elongin C complexes decrease SOCS protein expression by promoting degradation. Though Kamura do not specifically teach that the SOC box/elongin complex decreases SOCS protein expression by promoting degradation, the artisan would immediately envision this based on the teaching of Kamura. If increased expression occurs via inhibiting degradation, then it would stand to reason, in absence of evidence to the contrary, that decreased expression occurs via promoting degradation.

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7. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamura et al. The claims recite methods for identifying agonists and antagonists of protein degradation by promoting or inhibiting, respectively, SOCS box/elongin C interaction. Kamura teach SOCS box/elongin BC complex increases expression of the SOCS-I protein by inhibiting its degradation. Though Kamura do not specifically teach that the SOC box/elongin complex decreases SOCS protein expression by promoting degradation, it would have been obvious to one of ordinary skill in the art at the time of the present invention that, based on the teaching of Kamura, if increased expression occurs via inhibiting degradation, then it would stand to reason, in absence of evidence to the contrary, that decreased expression occurs via promoting degradation.

8. Conclusion

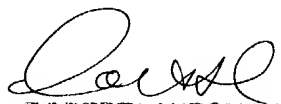
A. No claim is allowable.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on M-Th 9 AM-6 PM (eastern); alt F 9 AM-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ROBERT LANDSMAN
PATENT EXAMINER

Robert Landsman
Primary Examiner
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